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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,283	11/05/2001	Douglas F. Connor	020431.1055	7058
53184	7590	06/04/2007	EXAMINER	
i2 TECHNOLOGIES US, INC. ONE i2 PLACE, 11701 LUNA ROAD DALLAS, TX 75234			TARAE, CATHERINE MICHELLE	
ART UNIT		PAPER NUMBER		
3623				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/992,283	CONNOR ET AL.	
	Examiner	Art Unit	
	C. Michelle Tarae	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 March 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5,7-14,16,18-25,27 and 29-35 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5,7-14,19-25 and 30-35 is/are rejected.
- 7) Claim(s) 16,18,27 and 29 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 20, 2007 has been entered.

Claims 1, 5, 12, 16, 23, 27 and 34 have been amended. Claims 4, 6, 15, 17, 26 and 28 have been canceled. Claims 1-3, 5, 7-14, 16, 18-25, 27 and 29-35 are now pending in this application.

Allowable Subject Matter

2. Examiner notes that in the Final Office Action mailed August 25, 2006, the previous Examiner objected to claims 6-7, 17-18 and 28-29 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The current amendment to the claims still do not place the application in condition for allowance because the dependent claims were not properly rolled into independent claims since the independent claims did not include all of the correct intervening claims as the claims were listed in the Final Office Action.

For example, claim 6 was dependent on claim 5, which was dependent on claim

1. The current amendment does not include the limitations of claims 6 and 5 into claim

1, but instead includes the limitations claims 6 and 4 into claim 1. Likewise, claim 17 was dependent on claim 16, which was dependent on claim 15, which was dependent on claim 12. The current amendment does not include the limitations of claims 17-15 into claim 12, but instead includes the limitations of claims 17 and 15 into claim 12. Lastly, claim 28 was dependent on claim 27, which was dependent on claim 26, which was dependent on claim 23. However, the current amendment does not include all of the limitations of claims 28-26 into claim 23, but instead includes the limitations of claims 28 and 26 into claim 23.

Accordingly, in keeping with the previous Examiner's indication of allowable subject matter, claims 5, 7, 16, 18, 27 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

3. Applicant's arguments are deemed moot in view of the new grounds of rejections provided below.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-3, 5, 7-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 recites a system

comprising one or more software components. The current claim language does not specify the software is part of or statically embodied in a physical medium. Software not statically embodied on a physical medium is considered descriptive material *per se*. It is therefore considered non-statutory because it is not capable of causing a functional change in a physical medium. As drafted, the claim fails to define any structural and functional interrelationships between the software *per se* and other elements of a physical medium of the invention that permit the software's function to be realized.

(See MPEP § 2106 Section IV B 1 (a).)

Additionally, it is unclear if Applicant intends for the system to comprise more than one component (software or otherwise) as a system comprising only one component could raise potential "single means" issues, where "single means" claims are subject to 35 U.S.C. 112, first paragraph rejections as having undue breadth. (See MPEP § 2164.08(a).)

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3, 9-12, 14, 20-23, 25 and 31-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Heinrich (U.S. 6,895,383).

As per claims 1, 12, 23, and 34-35, Heinrich teaches a system for generating risk assessment regarding software implementation projects comprising software components operable to:

access a specified importance value and maximum score for each risk factor (col. 5, lines 22-26; col. 7, lines 33-47; col. 13, lines 46-47; Figure 2; Each risk band has a maximum risk value and each risk category has an importance coefficient.), the importance of each risk factor reflecting experience of an implementing entity regarding the extent to which the risk factor may negatively impact a software implementation project if the risk factor is not adequately addressed (col. 3, lines 31-36; col. 4, lines 25-27; col. 8, lines 33-34), the importance value and maximum score for each factor is multiplied to define a potential weighted score for each factor (col. 10, lines 25-63; The potential weighted score, or absolute risk value, for a component, or risk factor, is determined.);

receive an actual score for each factor based on an analysis by the implementing entity specific to the particular software project and generate an actual weighted score for each risk factor by multiplying the importance value and the actual score for the risk factor (col. 11, lines 45-52; The relative risk value, or actual risk score, for each component, or factor, is determined.);

determine a relationship between the potential weighted score and the actual weighted score for each factor (equation at col. 11, line 52 shows the relationship

between the absolute risk value of a component (i.e., the potential weighted score) and the relative risk value of the component (i.e., the actual score).);

assign a risk level for the particular project to each risk factor according to the relationship between the potential weighted score and the actual weighted score for the risk factor, the risk level for each factor representing an assessment by the implementing entity regarding the extent to which the factor is not adequately addressed (col. 11, lines 45-52; Each component is assigned a risk factor relative to the overall system.);

generate a risk assessment for the project comprising one or more of the assigned risk levels for the project for one or more corresponding risk factors, wherein each risk factor is associated with one of a plurality of risk factor categories, each risk factor category comprising one or more risk factors (col. 13, lines 43-51; The overall risk for the system is determined by assessing the risk for each category.); and

generate a risk factor category scorecard for display, the risk factor category scorecard providing at least one of a plurality of risk factor categories and data associated with each of the plurality of risk factor categories, the data selected from the group consisting of a category actual score, a category maximum score, and a category percentage risk (col. 6, lines 22-26 and 61-65 col. 20, lines 5-40; Table 1 in col. 15 and Table 2 in col. 20 show the results of a risk analysis.).

As per claims 3, 14 and 25, Heinrich teaches the maximum score is the same for each risk factor; and the importance value and maximum score for a risk factor remain constant across multiple projects (col. 5, lines 22-26; col. 7, lines 33-47; col. 13, lines

46-47; Figure 2; Each risk factor in the same risk band has the same maximum risk value. The importance value for a component remains the same throughout the risk assessment for a project.).

As per claims 9, 20 and 31, Heinrich teaches the actual score for a risk factor is determined by the implementing entity and is based on an evaluation of client resources and capabilities relevant to the risk factor (col. 8, lines 26-35; The risk data is determined by the implementing entity and based on their evaluation of the system/components under review.).

As per claims 10, 21 and 32, Heinrich teaches the relationship between the potential weighted score and the actual weighted score for each risk factor, determining assignment of the risk level for the risk factor, is a percentage based on one minus the quotient of the actual weighted score and the potential weighted score for each risk factor (col. 5, lines 22-26; The risk levels for different factors are expressed as a number between 0 and 1, or as a percentage.).

As per claims 11, 22 and 33, Heinrich teaches the maximum score is a maximum attainable score (col. 7, lines 33-37; Each risk band has a maximum risk value that represents the highest risk value attainable for that band.).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinrich (U.S. 6,895,383) in view of Bowman et al. (U.S. 2003/0061246).

As per claims 2, 13 and 24, Heinrich does not explicitly teach a risk assessment scorecard for display which provides risk factors and the importance value, maximum score, potential weighted score, actual score, actual weighted score and risk level for each factor in a spreadsheet format. However, Heinrich does teach displaying risk assessment data in a tabular, or spreadsheet-like, format (Table 1 in col. 15; Table 2 in col. 20). The content of the data presented in the risk assessment scorecard is mere design choice as it does not affect the underlying functionality of the system. See MPEP §2144.04, IV, section B. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the risk assessment system of Heinrich to display a scorecard with various risk assessment data because displaying a risk assessment scorecard in a spreadsheet-like manner provides an easy-to-understand and user-friendly means of displaying risk assessment data.

Claims 8, 19 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinrich (U.S. 6,895,383).

As per claims 8, 19 and 30, Heinrich does not expressly teach the implementing entity is a seller of software to be implemented in the particular software implementation project at one or more sites of a client. However, the job title or job function of the person using the risk assessment system does not change the structure of the risk

assessment system or the function that it can perform. Therefore, the job title or job function of the people using risk assessment system does not hold any patentable weight, as the job title or job function does not change the structure of the apparatus or the functions it performs, thereby acting as non-functional descriptive data. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); *In re Ngai*, 367 F.3d 1336, 1336, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004); MPEP § 2106. Thus, at the time of the invention it would have been obvious to a person of ordinary skill in the art for the system of Heinrich to have the implementing entity be a seller of software to be implemented in the particular software project because the risk assessment system would allow the seller to evaluate potential risks associated with implementing the software with the project, thereby allowing the seller to prevent identified potential risks before they actually occur.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Spielmann et al. (U.S. 7,113,914) discusses a system for managing risks;
- Packwood (U.S. 7,006,992) discusses a system and method for risk assessment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



C. MICHELLE TARAЕ
PRIMARY EXAMINER

March 28, 2007